

REMARKS

Applicants respectfully request consideration in view of remarks set forth fully below. Claims 1-22 were previously pending in the present application. Of the above Claims 1-8 have been withdrawn from consideration. Within the Office Action, Claims 9-22 were rejected.

Double Patenting Rejection

Within the Office Action, Claims 9-22 were rejected on the grounds of nonstatutory obviousness-type double patenting over United States Patent No. 6,510,417. To overcome this rejection, the Applicants submit a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(b).

Claim Rejections under 35 U.S.C. § 102(e)

Within the Office Action, Claims 9-22 were rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,807,574 to Partovi *et al.* (hereinafter referred to as "Partovi"). The Applicants respectfully traverse this rejection because Patovi is not prior art as defined by 35 U.S.C. § 102(e). Specifically, the Applicants conceived of the invention prior to the effective date of Partovi and the Applicant was diligent in reducing the invention to practice between the time the invention was conceived and the time the application was filed.

A Declaration under 37 CFR 1.131 is submitted herewith to establish invention of the subject matter of the rejected claims prior to the effective date of Partovi, thereby removing Partovi as a prior art references under 35 U.S.C. § 102(e). The Declaration, signed by Applicant's attorney, Michael A. Glenn is based on information and belief of the facts and is prepared under 37 C.F.R. §1.64(b). Mr. Glenn is the legal representative of the Applicant.

The relevant date to overcome is Partovi's filing date of October 22, 1999. The enclosed Declaration establishes conception of the invention as early as September 17, 1999, along with diligence in reducing the invention to practice from September 17, 1999 through March 21, 2000, the filing date of this instant application.

For at least this reason, Partovi is not prior art as defined by 35 U.S.C. § 102(e) and the Applicants respectfully request that the rejections based on novelty in light of Partovi be withdrawn.

Claim Rejections under 35 U.S.C. § 103

Also within the Office Action, Claims 11 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Partovi in view of United States Patent No. 5,999,929 to Goodman (hereinafter referred to as "Goodman"). The Applicants respectfully traverse this rejection, because Partovi is not prior art and because Goodman does not disclose all of the limitations of Claims 11 and 22.

To establish a *prima facie* case of obviousness of a claimed invention, all the claimed features must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As explained above, Partovi is not prior art under 35 U.S.C. § 102(e) and therefore cannot be used as prior art to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Furthermore, Goodman does not teach or suggest all of the claimed features of Claims 11 and 22. Specifically, Goodman does not teach or suggest "[a] voice-controlled transaction service adapted to process transactions over the Internet, the service comprising: a user interface; and at least one database coupled to the user interface, the user interface coordinating voice communications with a user, the voice communications including item or service information and transactions associated with the item or service, the at least one database storing item and service information; whereby transactions are executed without the user pressing a button, clicking a mouse, or any other manual input to a computing device," nor does the Examiner suggest that it does.

On the contrary, Claims 11 and 22 recite this limitation by reference to Claims 9 and 20. For at least this reason, Claims 11 and 22 are not rendered obvious in light of a hypothetical combination of Partovi and Goodman.

Conclusion

As set forth above, all of the rejections have been overcome. Therefore Claims 9-22 are in condition for allowance and an early issuance of a Notice of Allowance would be appreciated.

Should the Examiner have any questions regarding the application, he is respectfully urged to contact Applicant's attorney at (650) 474-8400.

Respectfully submitted,



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